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09/835,888	04/16/2001	Robert Jan Jonker	ACH2784US	4552

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Louis A. Morris  
Akzo Nobel Inc.  
7 Livingstone Avenue  
Dobbs Ferry, NY 10522-3408

EXAMINER

QUAN, ELIZABETH S

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 07/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/835,888

Applicant(s)

JONKER, ROBERT JAN

Examiner

Elizabeth Quan

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to the apparatus for testing samples of a solid material, classified in class 422, subclass 65.
  - II. Claims 9-11, drawn to the method of testing a plurality of samples of a solid material, classified in class 436, subclass 47.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus, as the method does not recite the particulars of the apparatus, such as the conveyor. The process as claimed can be practiced by hand.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Louis A. Morris on 6/25/2003 a provisional election was made with traverse to prosecute the invention of II, claims 9-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

7. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the reactor tubes, holder for a tube, magazine for additional tubes, and automated desorption unit must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance .

***Specification***

10. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood how the reactor tube, holder, and magazine have an automated thermal desorption unit. The specification does not explain how, and the drawings do not show the elements let alone each having an automated thermal desorption unit.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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14. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Referring to claim 10, previous claim 9 recites “a flow module for generating a carrier fluid flow containing a probe” and “generating a carrier fluid flow through said tube” and claim 10 recites that the “probe and/or additional carrier fluid is injected into the carrier fluid flow relatively close to said holder.” Does the flow module with the probe contain and inject the carrier fluid, as recited in claim 9? Or, does the flow module withdraw fluid from somewhere near the holder? How can the probe and/or additional carrier fluid inject into the carrier fluid flow? What is meant by additional carrier fluid?

16. Referring to claim 11, it is unconceivable how each of the reactor tube, holder, and magazine comprise an automated thermal desorption unit.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,976,924 to McAndless et al.

Referring to claim 9, McAndless et al. disclose a method of testing a plurality of samples of a solid material contained in a reactor tube by means of an apparatus comprising a holder for a tube, a flow module for generating a carrier fluid flow

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comprising a probe, and a magazine holding additional tubes (see COL. 1, lines 55-68; COL. 2, lines 1-21; COL. 3, lines 14-18, 43-47, and 63-68; COL. 4, lines 1-26 and 37-39). The method comprises placing the tube in the holder, generating a carrier fluid flow through the tube, and replacing the tube with an additional tube from the magazine (see COL. 1, lines 55-68; COL. 2, lines 1-21; COL. 3, lines 14-18, 43-47, and 63-68; COL. 4, lines 1-26 and 37-39).

Referring to claim 10, Examiner has interpreted that the probe provides carrier fluid to the tube, and since the tube is within the holder, the probe would be relatively close to the holder during the providing of fluid. McAndless et al. disclose that a probe provides air to clean the absorption material within the tube and the inner walls of the tube (see COL. 1, lines 62-68; COL. 2, lines 1 and 2; COL. 3, lines 63-68; COL. 4, lines 1-27).

Referring to claim 11, Examiner has interpreted that the system comprising of the reactor tube, holder, and magazine comprises of an automated thermal desorption unit. McAndless et al. disclose that the reactor tube, holder, and magazine are within an automated thermal desorption unit (see ABSTRACT; COL. 1, lines 62-68; COL. 2, lines 1 and 2; COL. 3, lines 63-68; COL. 4, lines 1-27).

Applicant has not provided a definition of probe nor show what the probe looks like in the drawings. According to Merriam-Webster's Collegiate Dictionary, a probe is defined as any of various testing devices or substances: as (1) : a pointed metal tip for making electrical contact with a circuit element being checked (2) : a usually small object that is inserted into something so as to test conditions at a given point (3) : a device used

to penetrate or send back information especially from outer space or a celestial body (4) : a device (as an ultrasound generator) or a substance (as DNA in genetic research) used to obtain specific information for diagnostic or experimental purposes **b** : a pipe on the receiving airplane thrust into the drogue of the delivering airplane in air refueling.

Therefore, the pipe in combination with the manifold and valves as disclosed in

McAndless et al. suffices as a probe that assists in testing by dispensing heated air.

Furthermore, the art accepted definition of probe is one in which that can dispense. For examples, see U.S. Patent No. 6,485,692 to Freitag et al., U.S. Patent No. 5,344,610 to Shaw, U.S. Patent No. 4,108,608 to Maher, Jr. et al., etc.

Therefore, McAndless et al. includes all the limitations in claims 9-11.

19. Claims 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,866,004 to Houck et al.

Referring to claim 9, Houck et al. disclose a method of testing a plurality of samples of a solid material contained in a reactor tube (16) by means of an apparatus comprising a holder (18) for a tube (16), a flow module (12) for generating a carrier fluid flow comprising a probe (32), and a magazine (14) holding additional tubes (16) (see ABSTRACT; SUMMARY OF THE INVENTION; FIGS. 1-7; COL. 2, lines 63-67; COL. 3, lines 1-6, 19-36; COL. 4, lines 66 and 67; COL. 5, lines 1-4; COL. 6, lines 25-36 and 50-67; COL. 7, lines 1-30; COL. 13, lines 13-23, 47-56, and 65-67; COL. 14, lines 1-3; COL. 21, lines 7-19; COL. 22, lines 27-37). The method comprises placing the tube (16) in the holder (18), generating a carrier fluid flow through the tube (16), and replacing the tube (16) with an additional tube (16) from the magazine (14) (see FIGS. 1-



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7; COL. 2, lines 63-67; COL. 3, lines 1-6, 19-36; COL. 4, lines 66 and 67; COL. 5, lines 1-4; COL. 6, lines 25-36 and 50-67; COL. 7, lines 1-30; COL. 13, lines 13-23, 47-56, and 65-67; COL. 14, lines 1-3; COL. 21, lines 7-19; COL. 22, lines 27-37).

Referring to claim 10, Examiner has interpreted that the probe provides carrier fluid to the tube, and since the tube is within the holder, the probe would be relatively close to the holder during the providing of fluid. Houck et al. disclose that a probe (32) provides supercritical fluid to extract analyte from a sample (see ABSTRACT; COL. 2, lines 63-67; COL. 4, lines 66 and 67; COL. 5, lines 1-4; COL. 6, lines 66 and 67; COL. 7, lines 1-30).

Referring to claim 11, Examiner has interpreted that the system comprising of the reactor tube, holder, and magazine comprises of an automated thermal desorption unit. Houck et al. disclose that the system with the reactor tube, holder, and magazine comprises an automated thermal desorption unit (see FIG. 1; COL. 3; COL. 4, lines 66 and 67; COL. 5, lines 1-4; COL. 6, lines 66 and 67; COL. 7, lines 1-46; COL. 13, lines 6-67; COL. 14, lines 1-5; COL. 15, lines 48-64; COL. 21, lines 7-19; COL. 22, lines 28-37).

Therefore, Houck et al. includes all the limitations in claims 9-11.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They include one or more limitations in the claims.

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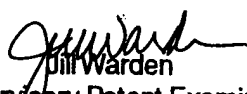
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan  
Examiner  
Art Unit 1743

eq  
June 30, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700